UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/036,236	03/06/1998	DAVID M. OLIVER	005-905-300	5721

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EXAMINER
THOMPSON JR, FOREST

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

		Application No.		Applicant(s)
Office Action Summary		09/036,236		OLIVER ET AL.
		Examiner		Art Unit
		Forest O. Thompson Jr.		3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 December 2002_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-82_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-82_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _06 March 1998_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)		4)☐ Interview Summary (PTO-413) Paper No(s). _____ .	
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5)☐ Notice of Informal Patent Application (PTO-152)	
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6)☐ Other:	

DETAILED ACTION

Response to Amendment

1.   Applicants have filed (on 12/30/2002) a Request for Continued Examination (see Paper #29) and a Preliminary Amendment (see Paper #30) that added new claims 81and 82. Claims 1-82 are pending.

2.   Paper #30 also presented a Declaration statement under 37 CFR 3.73 that Clickshare Service Corporation is the assignee of the entire right, title, and interest in this patent application.

3.   Paper #30 also presented copies of 3 papers assigning the entire right, title and interest in the invention System For Management Of Transactions On Networks, one signed by each inventor. The copy signed by David M. Oliver (dated 07/07/1998) sold and assigned the entire right, title and interest in the invention to Newshare Corporation (the Assignee). Each of the copies signed by William P. Densmore, Jr. (dated 06/05/1998) and Michael J Callahan (dated 07/17/1998) sold and assigned the entire right, title and interest in the invention to Clickshare Service Corporation. PALM records indicate that Newshare Corporation assigned its Assignor interest to Clickshare Service Corporation on 08/13/1998.

4.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (see Paper No. 4), or will be included here for clarity, as

necessary. The text of those sections of Title 35, U.S. Code not otherwise provided in a

prior Office action will be included in this action where appropriate.

5.   Claims 1-82 have been examined.

Declaration

6.   Paper #30 included a Declaration signed by William P. Densmore, Jr. (one of the

applicants), dated 12/22/2002, that an enclosure (a memo) was transmitted during 1995

and thereafter to a number of independent third parties, subject to non-disclosure

agreement. The memo (which disclosed a copyright date of 1995) is declared to

disclose the existence of the applicants' invention in 1995. Additionally, PALM records

disclose that applicants filed a Provisional Patent Application on 03/07/1997, and a non-

provisional patent application on 03/06/1998.

Drawings

7.   New corrected drawings are required in this application because this application

has been filed with informal drawings which are acceptable for examination purposes

only. New corrected drawings are required in this application for the reasons set forth

on the PTO-948 Form as enclosed in Paper #4. Applicant is advised to employ the

services of a competent patent draftsperson outside the Office, as the U.S. Patent and

Trademark Office no longer prepares new drawings. The corrected drawings are

required in reply to the Office action to avoid abandonment of the application. The

requirement for corrected drawings will not be held in abeyance.

Priority

8.   The following priority dates were used in this examination:

-       Teper et al. (Patent #5,815,665) - filing date: Apr. 3, 1996, priority date: Apr. 3,

1996

-       Applicants' filing (Patent Application #09/036,236) - filing date: Mar. 6, 1998,

priority date: Mar. 7, 1997 based on provisional application #60/040,223

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

10.   Claims 35-80 are rejected under 35 U.S.C. 112, first paragraph, as containing

subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. Claims 35, 49, 63, 69,

71, 75, and 79 disclose that the on-line broker, not the service provider that registers

and logs on the user, authenticates the user to the system. Applicants' specification

discloses that the on-line provider that registers the user and provides authentication of

users to the system (see pg. 7 lines 18-26). Therefore, claims 35-80 introduce new

matter into applicants' application.

The First Action mailed on 03 June 1999 (see Paper #4) rejected all claims in the

original application. The Final Action mailed on 07 December 1999 (see Paper #11)

and the Final Action mailed on 01/15/2002 rejected all claims as amended in

amendments A and B (see Papers # 7 & 8). No other amendment had been filed. The

rejections presented in the First Action and the Final Action are maintained, and are

repeated below for the claims, as amended. Additionally, new claim 81 and 82 are

rejected below.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-82 are rejected under 35 U.S.C. 102(b) based on a public use or sale of

the invention as evidenced by: "online privacy;" Red Rock Eater Digest; 02/08/2003,

which discloses the article titled: "Clickshare(sm) alpha up; 'test drives' available;"

Newshare Corp., 24 October 1995 (hereafter referred to as RedRock1).

RedRock1 discloses the invention in public use or on sale in this country, more than one year prior to the date of application for patent in the United States (pg. 1). This disclosure clearly anticipates applicants' invention. Therefore, claims 1-82 are rejected.

12.   Claims 35-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Teper et al. (U.S. Patent No. 5,815,665).

Applicants state in paper #8 at pg. 3 last paragraph that these claims are copied from Teper et al. Therefore, they are rejected as being unpatentable over prior art (Teper et al.).

13.   Claims 81 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson et al. (U.S. Patent No. 5,819,092).

As per claim 81, Ferguson et al. discloses a plurality of separate user registration databases, a provider database, a settlement server, said user registration databases and said user account databases being independent and remotely located with respect to each other (Abstract; fig. 1 [170, 180, 107]; col. 9 lines 10-20).

As per claim 82, Ferguson et al. discloses storing users' identifications, and user account reference information in a database associated with the user; requesting the posting of a transaction to a user's account, without disclosing user identification to a posting party; receiving the request at a settlement server from the posting party;

accessing a user registration database at a settlement server; communicating the

request and a user identity to a corresponding one of a plurality of user account

databases; and independently maintaining the user registration databases and the user

account databases at remote locations (Abstract; fig. 1 [170, 180, 107]; col. 9 lines 10-

20).

Claim Rejections - 35 USC § 103

14.   Claims 1, 3-7, 11-18, 20-24, and 28-34 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Teper et al. (Patent No. 5,815,665).

As per claim 1, Teper et al. teach:

-     a mechanism for sharing client information and charges among a plurality of

service providers (col. 6 lines 21-34; col. 8 lines 63-67; col. 9 lines 1-8);

-     a client who is registered with one of the service providers and is allowed to

access the resources of the other service providers (col. 5 lines 30-37 and 45-48; col. 6

lines 1-49);

-     a settling means adapted to allow the system to settle accounts among service

providers (col. 6 lines 4-13, 22-34 and 46-49);

-     a sharing means adapted to allow the system to allow the providers to share

users without requiring an open account for each user at each provider (col. 6 lines 38-

67);

-     a verification means including a token and an authentication server adapted to

allow each provider to determine if a particular client is a member of the system, verify

that the client has authenticated at his home provider, and determine this client's access or service privileges and criteria (col. 5 lines 30-37 and 45-48; col. 6 lines 53-61).

As per claim 1, Teper et al. does not teach, explicitly, a payment means adapted to assure that the outside providers are then paid for that access through the system. However, Teper et al. teaches payment for these services by the user is to the Online Broker, who settles accounts billed by the Service Providers to authorized users (Col. 2 lines 32-38 and 62-65; col. 3 lines 19-41; col. 4 lines 22-27; col. 6 lines 4-13, 22-34 and 37-49). Also, Teper et al. (col. 15 lines 11-15) incorporates by reference Reeder, U.S. Patent No. 5,852,812, "Billing System For A Network" which teaches a payment means that relies on a centralized Online Broker site to handle billing matters for online services purchased by users from Service Providers. Payment for these services by the user is to the Online Broker, who pays Service providers for services billed by the Service Providers to users (Reeder, col. 6 lines 9-18). Therefore, it would have been obvious to one skilled in the computer and electronic commerce art at the time the invention was made to use the teachings of Teper et al. and Reeder to incorporate the payment function at an Online Broker to receive payment from the user for the services provided, and to pay the individual Service Providers accessed and used by the user (for their services during an online session) from the combined payment that the Online Broker receives from the user, because of the obvious advantages of time, expense and convenience of the user submitting payment information only once during an online session, the Online Broker processing only one payment (e.g., a credit card payment)

from the user for the services received by the user during one online session from all

Services Providers and the Online Broker, and the Service Providers not being required

to maintain complete user data files for access authorization and billing information for

each user.

As per claim 3, Teper et al. teach one member of the system may

instantaneously configure the form and substance of services or goods across a data

network provided to different or unique clients in response to data about the client

provided by the system along with the client's request for service (col. 3 lines 65-67; col.

4 lines 1-6).

As per claim 4, Teper et al. teach one member of the system may

instantaneously determine whether or what type or form of service or goods across a

data network to provide to different or unique clients of the system based upon data

about the client provided along with the client's request for service (col. 3 lines 65-67;

col. 4 lines 1-6).

As per claim 5, Teper et al. teach multiple members of the system may

aggregate, transfer and share data about the clients of the system (col. 8, lines 63-67;

col. 9 lines 1-15).

As per claim 6, Teper et al. teach a client of the system may request access to, review of, or purchase of resources or goods across a data network of members of the system on the basis of specific attributes of the client (fig. 2; col. 9 lines 9-15).

As per claim 7, Teper et al. does not teach explicitly a provider of service under the system provides a client's preference, pricing and service-class information to a common service point in exchange for an authenticatable token, which the service provider then provides to its client (fig. 4; col. 15 lines 21-51 and 57-61; col. 17 lines 64-67; col. 18 lines 1-17). However, Teper et al. does teach a provider of service under the system provides a client's preference, pricing and service-class information to a common service point in exchange for an authenticatable token, which the service provider then maintains for its client (fig. 4; col. 15 lines 21-51 and 57-61; col. 17 lines 64-67; col. 18 lines 1-17). In this configuration, the user connects to other service providers through its "home" service provider which passes the token to other service providers as the user accesses them through the auspices of its "home" service provider which maintains the user's token(s). This configuration is similar to that stated in the claim, with the principal difference being a "home" service provider (rather than the user directly) maintaining the user's token, and then connecting and transferring the token to selected service provider when the user attempts to connect to this selected service provider through his "home" service provider. The functionality of the connection for purposes of accessing service providers is the same. Therefore, it would have been obvious to one of ordinary skill in the computer and electronic commerce art

at the time of the invention that the use of a token could simplify the connectivity

process and provide some protection for the user's data provided to the user's "home"

service provider by the user, because only selected components of the user's data (e.g.,

name, address, or other data) need to be transmitted, while selected components of the

data (e.g., user's credit card ID) need never be transmitted over unsecured

communications paths.

As per claim 11, Teper et al. teach collecting and storing at a common service

point discrete records of access by clients to resources and goods across a data

network of multiple members of the service (col. 3 lines 31-41);

As per claim 12, Teper et al. teach discrete records are instantaneously sorted

and stored in databases according to the identity of the service provider of the individual

client whose activity resulted in the record being produced (col. 3 lines 41-44).

As per claim 13, Teper et al. teach collecting and aggregating records of financial

charges for access to, review or acquisition of services or goods across a data network

(col. 3 lines 41-44);

As per claim 14, Teper et al. teach said token is only "read" by the authentication

server (Fig. 6; col. 3 lines 19-25; col. 15 lines 57-61; col. 16 lines 19-24).

As per claim 15, Teper et al. teach enabling an initiating Internet World Wide Web host to present in HyperText Markup Language (HTML) "hypertext links" which address services or goods available from multiple other receiving World Wide Web sites (fig. 4; col. 16 lines 48-59).

As per claim 16, Teper et al. teach a sequence means adapted for obtaining, transferring and maintaining among multiple network clients a unique alphanumeric sequence associated with a specific digital information resource or object (col. 3 lines 31-44).

As per claim 17, Teper et al. teach a sequence means adapted for obtaining, transferring and maintaining among multiple network clients and their server a dynamically updated record of funds encumbered by a network user for the purchase of a digital information resource or resources (col. 3 lines 35-41).

Claim 18 is written as a method and contains essentially the same limitations as claim 1; therefore, the same rejection is applied.

Claim 20 is written as a method and contains essentially the same limitations as claim 3; therefore, the same rejection is applied.

Claim 21 is written as a method and contains essentially the same limitations as claim 4; therefore, the same rejection is applied.

Claim 22 is written as a method and contains essentially the same limitations as claim 5; therefore, the same rejection is applied.

Claim 23 is written as a method and contains essentially the same limitations as claim 6; therefore, the same rejection is applied.

Claim 24 is written as a method and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

Claim 28 is written as a method and contains essentially the same limitations as claim 11; therefore, the same rejection is applied.

Claim 29 is written as a method and contains essentially the same limitations as claim 12; therefore, the same rejection is applied.

Claim 30 is written as a method and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

Claim 31 is a duplicate of claim 14 and contains the same limitations as claim 14; therefore, the same rejection is applied.

Claim 32 is written as a method and contains essentially the same limitations as claim 15; therefore, the same rejection is applied.

Claim 33 is written as a method and contains essentially the same limitations as claim 16; therefore, the same rejection is applied.

Claim 34 is written as a method and contains essentially the same limitations as claim 17; therefore, the same rejection is applied.

15.   Claims 2 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Teper et al. (Patent No. 5,815,665) as applied to claim 1 above, and further in view of

Reeder (Patent No. 5,852,812) and Reuhl et al. (Patent No. 5,873,069).

As per claim 2, Teper et al. does not explicitly teach the owner of goods may sell

access to those goods across a data network such that the owner may instantaneously

and simultaneously display across the network multiple differing prices of the same

good or classes of goods depending upon the alternative pricing requirements of other

clients of the system as transferred by the system (col. 4 lines 43-46; col. 5 lines 49-55;

col. 6 lines 21-34; col. 8 lines 63-66). However, Reeder teaches

-a series of customers are linked through a gateway to a host data center (fig. 2

[12a, 12b, 12c, 14]; col. 5 lines 6-7);

-the host data center communicates with several outside services (col. 5 lines 11-

12);

-the host data center also communicates with a billing services center that can

provide invoices (col. 5 lines 26-27);

-the host data center can also communicate with remote data centers so that

events that occur on the remote data centers can be communicated to the host data

center for processing (col. 5 lines 44-47);

-content providers can provide services to customers attached to the host data

center (col. 6 lines 5-7);

-content providers charge an additional fee for access to their services (col. 6

lines 9-10);

-the owner of the host data center collects money from the customers for the services provided by the content provider, and the owner of the host data center pays royalties to the content provider (col. 6 lines 9-19).

Since Reeder is incorporated by reference into Teper et al., it would have been obvious to one skilled in the computer and commerce art at the time the invention was made to use the teachings of Teper et al. and Reeder to incorporate the capability that the owner of goods may sell access to those goods across a data network, because a data network provides access to a very large potential customer base for the purchasing of the owner's goods. Reeder and Teper et al. do not teach the owner may instantaneously and simultaneously display across the network multiple differing prices of the same good or classes of goods depending upon the alternative pricing requirements of other clients of the system as transferred by the system.

However, Reuhl et al. teaches an ability to automatically implement prices responses to market changes, on a product-by-product, market-by-market basis, and the system is suitably an enterprise -wide system and price changes are directed on a market-by-market basis (col. 6 lines 18-44). Therefore, it would have been obvious to one of ordinary skill in the computer art at the time of applicant's invention to modify the teachings of Teper et al. and Reeder with the teachings of Reuhl et al. to include the capability to sell access to goods across a data network such that the owner may instantaneously and simultaneously display across the network multiple differing prices of the same good or classes of goods depending upon the alternative pricing requirements of other clients of the system as transferred by the system, e.g.,

geographic locations of the users, because market competition in specific market areas

or the additional expenses of advertising, presentation, shipping, and handling costs

may effect the costs to the owner of goods.

Claim 19 is written as a method and contains essentially the same limitations as

claim 2; therefore, the same rejection is applied.

16.   Claims 8-10 and 25-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Teper et al. (Patent No. 5,815,665) as applied to claim 1 above, and

further in view of Payne et al. (Patent No. 5,715,314) and Willens et al. (Patent No.

5,889,958).

As per claim 8, Teper et al. teach [system] which employs the Internet's Hyper-

Text Transfer Protocol (HTTP) (col. 11 lines 34-45). Teper et al. does not teach

[system] has appending means adapted to appending to or including in a Uniform

Resources Locator, or in a Request/Response Header, a sequence of alphanumeric

characters which includes said authenticatable token. However, Payne et al. teach

[system] which employs the Internet's Hyper-Text Transfer Protocol (HTTP), and has

appending means adapted to appending to or including in a Uniform Resources

Locator, or in a Request/Response Header, a sequence of alphanumeric characters

which includes said authenticatable token (col. 3 lines 19-22; col. 5 lines 26-46).

Therefore, it would have been obvious to one of ordinary skill in the computer and

electronic commerce art at the time of the invention to combine the teachings of Teper

et al. and Payne et al. to teach a system which employs the Internet's Hyper-Text

Transfer Protocol (HTTP), and has appending means adapted to appending to or

including in a Uniform Resources Locator (URL), or in a Request/Response Header, a

sequence of alphanumeric characters which includes said authenticatable token,

because this provides security to the user information while providing the user the

capability to make purchases from service providers over secure and unsecured

communications links.

As per claim 9, Teper et al. teach an acceptance means by which a client's token

is accepted by a system member from whom to receive services or goods across a data

network, and is instantaneously submitted to the system's common service point (fig. 5

[80, 82, 84]; col. 15 lines 57-61; col. 16 lines 6-8 and 19-22;).

As per claim 10, Teper et al. does not teach utilizing the User Datagram Protocol.

However, Willens et al. teach utilizing the User Datagram Protocol in conjunction with

an access control system and process and firewall filtering of a server (col. 6 lines 10-

20). Official Notice is taken that the User Datagram Protocol is known in the computer

art. Therefore, it would have been obvious to one skilled in the computer and medical

art to combine the teachings of Teper et al., Willens and known computer and electronic

shopping art to incorporate the capability for implementing an acceptance means

incorporating the User Datagram Protocol, because of the obvious advantages of very

small data packet size requirements in an environment where data packet size affects the reliability and protocol requirements of the system.

Claim 25 is written as a method and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 26 is written as a method and contains essentially the same limitations as claim 9; therefore, the same rejection is applied.

Claim 27 is written as a method and contains essentially the same limitations as claim 10; therefore, the same rejection is applied.

Response to Arguments

17.   Applicant's arguments filed 11/25/2003 have been fully considered but they are not persuasive.

In Paper #30, applicants argue that an interference is appropriate for their application with U.S. Patent No. 5,815,665, based on the disclosure in Paper #30. As per the applicants' request for an interference with Teper et al., MPEP 2308 states (repeated from Paper #27):

37 CFR 1.608. Interference between an application and a patent; prima facie showing by applicant.

(b)   When the effective filing date of an application is more than three months after the effective filing date of a patent, the applicant, before an interference will be declared, shall file evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee and an explanation stating with

particularity the basis upon which the applicant is prima facie entitled to the judgment. Where the basis

upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence

shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported

by documentary evidence, if available, each setting out a factual description of acts and circumstances

performed or observed by the affiant, which collectively would prima facie entitle the applicant to

judgment on priority with respect to the effective filing date of the patent. To facilitate preparation of a

record (§ 1.653(g)) for final hearing, an applicant should file affidavits on paper which is 21.8 by 27.9 cm.

(8 ½ x 11 inches). The significance of any printed publication or other document which is self-

authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any

patent shall be discussed in an affidavit or the explanation. Any printed publication or other document

which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit.

Upon a showing of good cause, an affidavit may be based on information and belief. If an examiner finds

an application to be in condition for declaration of an interference, the examiner will consider the evidence

and explanation only to the extent of determining whether a basis upon which the application would be

entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be

declared.

   Under 37 CFR 1.608, an applicant seeking to provoke an interference with a patent is required to

submit evidence which demonstrates that the applicant is prima facie entitled to a judgment relative to the

patentee. Evidence must be submitted when the effective filing date of the application is more than 3

months after the effective filing date of the patent. The evidence may relate to patentability and need not

be restricted to priority, but if the evidence shows that the claims of the application are not patentable,

the claims in the application will be rejected. The applicant can file a request for reexamination of the

patent, if applicable.

2308.01 Patent Has Filing Date Earlier Than Application

When an applicant attempts to provoke an interference with a patent, the examiner must determine the

effective filing dates of the application and of the patent; only the patent's effective United States filing

date will be considered. Any claim of foreign priority by the patentee under 35 U.S.C. 119 will not be taken into account when determining whether or not an interference should be declared, in order to be consistent with the holding in In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966), that the effective date of a United States patent as a reference is not affected by the foreign filing date to which the patentee is entitled under 35 U.S.C. 119. If the patentee is determined to be entitled to the benefit of a prior United States application as to claimed subject matter involved in the interference, that application must be listed on the PTO-850 form (see MPEP § 2309).

Also, the following requirements apply:

If the effective filing date of the application is more than 3 months after the effective filing date of the patent, 37 CFR 1.608(b) requires that the applicant must file (1) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee, and (2) an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment.

If an applicant is claiming the same invention as a patent which has an earlier effective United States filing date but there is not a statutory bar against the application, and the applicant has not submitted the items required by 37 CFR 1.608(a) or (b), as appropriate, the application should be rejected under 35 U.S.C. 102(e) /103. A statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings. Note, however, 35 U.S.C. 135(b) and MPEP § 2307. The applicant should also be advised that an affidavit under 37 CFR 1.608(b) or evidence and an explanation under 37 CFR 1.608(b), as appropriate, must be submitted and it should be stated, if applicable, that the patentee has been accorded the benefit of an earlier U.S. application.

18.   The following priority dates were used in this evaluation:

-       Teper et al. (5,815,665) - filing date: Apr. 3, 1996, priority date: Apr. 3, 1996

-     Applicants' filing (09/036,236) - filing date: Mar. 6, 1998, and priority date: Mar. 7,

1997 based on provisional application #60/040,223

19.   Applicants have not submitted affidavits as required by MPEP, as quoted in

section 18 above.

20.   Additionally, as required by MPEP per section 18 above, applicant is notified that

the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but

only through interference proceedings. Note, however, 35 U.S.C. 135(b) and MPEP §

2307. Also, an affidavit under 37 CFR 1.608(b) or evidence and an explanation under

37 CFR 1.608(b), as appropriate, must be submitted and it should be stated, if

applicable, that the patentee has been accorded the benefit of an earlier U.S.

application.

21.   Based on the MPEP, as stated in section 17 above, and sections 18-20 above,

an interference is not granted to applicants. Examiner rejects: applicants' claims 35-80

as being unpatentable over Teper et al. for the reasons stated in section 12; and

applicants' claims 81-82 as being unpatentable over Ferguson et al. (U.S. Patent No.

5,819,092) for the reasons stated in section 13; applicants' claims 1, 3-7, 11-18, 20-24,

and 28-34 under 35 U.S.C. 103 as being unpatentable over Teper et al. for the reasons

stated in section 14; applicants' claims 2 and 19 under 35 U.S.C. 103(a) as being

unpatentable over Teper et al. (Patent No. 5,815,665) as applied to claim 1 above, and

further in view of Reeder (Patent No. 5,852,812) and Reuhl et al. (Patent No. 5,873,069)

for the reasons stated in section 15; applicants' claims 8-10 and 25-27 as being

unpatentable over Teper et al. (Patent No. 5,815,665) as applied to claim 1 above, and

further in view of Payne et al. (Patent No. 5,715,314) and Willens et al. (Patent No.

5,889,958) for the reasons stated in section 16;. Additionally, sections 8, 9, 10, and 11

above identify other issues that exist with applicants' argued priority. Applicants'

request for an interference with Teper et al. is not supported by the documentation

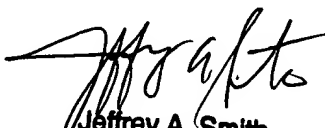provided by the applicants, as required by the MPEP as quoted above.

Conclusion

22.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Forest Thompson Jr. whose telephone number is (703)

306-5449. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 305-7687

for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

Forest Thompson Jr.
March 24, 2003

Jeffrey A. Smith
Primary Examiner